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09/750,154	12/29/2000	Scott M. Frank	BS00-086	7629

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/750,154

Applicant(s)

FRANK ET AL.

Examiner

Jonathan Ouellette

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000 and 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1, 11, and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

3. The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

4. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA

1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

5. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).
6. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts".

The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

7. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.
8. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding

the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

9. Independent Claims 1, 11, and 26 appear to be a process that is attempting to sell an intellectual property management and marketing service. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a “tangible” process and, therefore, non-statutory subject matter.
10. As to technological arts recited in the preamble (a system, computer-readable medium), mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.
11. Mere intended or nominal use of a component (system), albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**13. Claims 1-4, 11-13, 19-21, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Asplen, Jr. (US 6,044,354)**

14. As per independent Claim 1, Asplen discloses a method for determining whether to market an intellectual property asset, the method comprising: receiving a description of the intellectual property asset, the intellectual property asset based at least in part on an innovation developed for an internal need; and generating an assessment of the marketability of the intellectual property asset based at least in part on the description of the intellectual property asset and a marketing criterion (abstract, c2-c5).
15. As per Claim 2, Asplen discloses generating a marketing recommendation based at least in part on the generated assessment.
16. As per Claim 3, Asplen discloses wherein the marketing recommendation is an absolute recommendation based at least in part on a predetermined threshold.
17. As per Claim 4, Asplen discloses wherein the marketing recommendation is a relative recommendation based at least in part on a comparison of the generated assessment with one or more assessments of the marketability of the other intellectual property assets.
18. As per independent Claims 11, 19, and 26, Asplen discloses a method (system, computer-readable medium) for determining whether to market an intellectual property asset, the method comprising: determining a market potential assessment for the intellectual property asset, the intellectual property asset based at least in part on an innovation developed for an

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internal need; determining a marketing project timeframe assessment for the intellectual property asset; determining a projected revenue potential assessment for the intellectual property asset; determining a competitive threat assessment for the intellectual property asset; and determining a marketing opportunity assessment for the intellectual property asset based at least in part on the determined market potential assessment, the marketing project timeframe assessment, the projected revenue potential assessment, and the competitive threat assessment (abstract, c2-c5).

19. As per Claims 12, 20, and 27, Asplen discloses determining an intangible value assessment for the intellectual property asset, wherein the marketing opportunity assessment for the intellectual property asset is further based at least in part on the determined intangible value assessment.
20. As per Claims 13, 21, and 28, Asplen discloses determining that the intellectual property asset is to be marketed when the marketing opportunity assessment satisfies a predetermined threshold.

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



**22. Claim 5-10, 14-18, 22-25, and 29-34 are rejected under 35 U.S.C. 103 as being unpatentable over Asplen.**

23. As per Claims 5-10, Asplen does not expressly show wherein the marketing criterion includes (is selected from) a market potential criterion, a project timeframe criterion, a projected revenue criterion, a competitive threat criteria, an intangible value criterion, a marketing viability criterion, a potential customer service criterion, a competitive criterion, a development criterion, an ownership criterion, a patent status criterion, an interested customer criterion, a deal complexity criterion, a time to closing criterion, a competitive advantage criterion, a future deals criterion, a customer relationship criterion, an internal political criterion, and a public relations criterion.

24. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, computer-readable medium) for determining whether to market an intellectual property asset would be performed regardless of the type of marketing criterion used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a marketing criterion selected from the following: a market potential criterion, a project timeframe criterion, a projected revenue criterion, a competitive threat criteria, an intangible value criterion, a marketing viability criterion, a potential customer service criterion, a competitive criterion, a development criterion, an ownership

criterion, a patent status criterion, an interested customer criterion, a deal complexity criterion, a time to closing criterion, a competitive advantage criterion, a future deals criterion, a customer relationship criterion, an internal political criterion, and a public relations criterion, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

26. As per Claims 14, 22, 29, and 30, Asplen does not expressly show wherein the marketing potential assessment includes: a product viability assessment, a potential customer assessment, a competitive products assessment, a competitive suppliers assessment, a large market assessment, and a low market saturation assessment.
27. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, computer-readable medium) for determining whether to market an intellectual property asset would be performed regardless of the type of marketing potential assessment used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a marketing potential assessment selected from the following: a product viability assessment, a potential customer assessment, a competitive products assessment, a competitive suppliers assessment, a large market assessment, and a low market saturation assessment, because such data does not functionally relate to the steps

in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

29. As per Claims 15, 23, 24, 31, and 32, Asplen does not expressly show wherein the marketing project timeframe assessment includes: a product marketing readiness assessment, an ownership assessment, a patent status assessment, an identified interested customers assessment, a deal complexity assessment, and an anticipated time of revenue recognition assessment.
30. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, computer-readable medium) for determining whether to market an intellectual property asset would be performed regardless of the type of marketing project timeframe assessment used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
31. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a marketing project timeframe assessment selected from the following: a product marketing readiness assessment, an ownership assessment, a patent status assessment, an identified interested customers assessment, a deal complexity assessment, and an anticipated time of revenue recognition assessment, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

32. As per Claim 16, Asplen does not expressly show wherein the projected revenue potential assessment includes a projected total anticipated revenue assessment.
33. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, computer-readable medium) for determining whether to market an intellectual property asset would be performed regardless of the type of projected revenue potential assessment used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
34. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in a projected revenue potential assessment a projected total anticipated revenue assessment, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
35. As per Claim 17, Asplen does not expressly show wherein the competitive threat assessment includes an assessment whether marketing the intellectual property asset to a customer will give the customer a competitive advantage over a marketer of the intellectual property asset.
36. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, computer-readable medium) for determining whether to market an intellectual property asset would be performed regardless of the type of competitive threat assessment used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

37. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in a competitive threat assessment an assessment whether marketing the intellectual property asset to a customer will give the customer a competitive advantage over a marketer of the intellectual property asset, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
38. As per Claims 18, 25, 33, and 34, Asplen does not expressly show wherein the intangible value assessment includes an assessment whether marketing the intellectual property asset to a customer will increase a potential for future commercially advantageous transactions with the customer, an assessment whether marketing the intellectual property asset to a customer will foster internal organizational relations, and a public relations opportunity assessment.
39. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, computer-readable medium) for determining whether to market an intellectual property asset would be performed regardless of the type of intangible value assessment used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
40. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a intangible value assessment which includes one of the

following the following: an assessment whether marketing the intellectual property asset to a customer will increase a potential for future commercially advantageous transactions with the customer, an assessment whether marketing the intellectual property asset to a customer will foster internal organizational relations, and a public relations opportunity assessment, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

***Conclusion***

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

42. The following foreign patent is cited to show the best foreign prior art found by the examiner:

**PCT No. WO 200108031 A2 to Collins et al.**


Collins discloses a computer system for managing intellectual property.

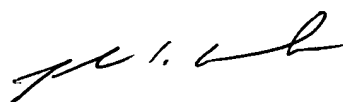
43. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

**Kempner, Richard; Sampson, Ian, "Many a slip," Managing Intellectual Property, v7n42, PP:15-26, September 1994.**

Kemper discloses some intellectual property management strategies.

44. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
46. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.
47. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

  
September 1, 2004

  
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